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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,096	05/31/2002	Hiroshi Tadano	450101-03381	1589

20999 7590 07/28/2004

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NEW YORK, NY 10151

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/048,096	Applicant(s) TADANO ET AL.	
	Examiner Igor Borissov	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/31/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Farrell et al. (US 6,751,663 B1).

Farrell et al. (hereinafter Farrell) teaches a method and system for aggregating network activity records, comprising:

Claim 1. Said method, including: storing IP addresses of the users as a table on a network (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); designating (supplying) by the user a static table of IP-to-username mappings (thereby indicating a pre-registration feature) (C. 22, L. 66-67); determining billing policies; and charging users based on said policies including chargeback (discount) options (C. 32, L. 64 – C. 33, L. 11).

Furthermore, Farrell teaches that the Internet service providers can migrate from a single flat rate fee business model to more flexible charging (C. 5, L. 16-19). For example, if the user accesses addresses which already exist in an Internet service provider cache, it would minimized the need to look up addresses for the requested sites, thereby triggering the "discount" feature (C. 5, L. 20-28); thereby inherently indicating that accessing addresses supplied by the user as IP-to-username mappings would trigger said "discount" feature.

Claim 2. Said method, including: storing in a table form IP addresses of the users of a network (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and IP-to-username mappings supplied by the users (C. 22, L. 66-67); providing flexible charging including, if the user accesses addresses which already exist in an Internet service provider cache, it would minimize the need to look up addresses for the requested sites, thereby triggering the "discount" feature (C. 5, L. 20-28).

Claim 3. Said method, including: storing in a table form IP addresses of the users and aggregating users in workgroups (C. 20, L. 34-61; C. 22, L. 35-66) and IP-to-username mappings supplied by the users (C. 22, L. 66-67); providing flexible charging including, if the user accesses addresses which already exist in an Internet service provider cache, it would minimize the need to look up addresses for the requested sites, thereby triggering the "discount" feature (C. 5, L. 20-28).

Claim 4. Said method wherein discounts are applicable to all users of a workgroup (C. 22, L. 35-66; C. 5, L. 20-28).

Claim 6. Said method, including: tabulating and storing IP addresses of the users of a network (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1) and IP-to-username mappings supplied by the users (C. 22, L. 66-67); aggregating users in workgroups (C. 20, L. 34-61; C. 22, L. 35-66); providing flexible charging for each address belonging to the same group including, if the user accesses addresses which already exist in an Internet service provider cache, it would minimize the need to look up addresses for the requested sites, thereby triggering the "discount" feature (C. 5, L. 20-28).

Claim 7. Said system, including: means for detecting and IP address of a communication party, and means for calculating the communication charge, wherein a discount is applied if said IP address is registered in advance (C. 5, L. 20-28; C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1).

Claim 8. Said system as in claim 7. Information as to *calculating by said user in the standard charge form...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 8 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 9. Said system as in claim 7. Information as to *said detection means obtain all flow information...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 9 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 10. Said system as in claim 7. Information as to *proper IP addresses are assigned to said user and said communication party...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished

from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 10 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 11. Said system, including a router and a data collector (C. 6, L. 24-41). Information as to *said detection means read said flow information...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 11 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 12. Said system, including means for calculating communication charges (C. 5, L. 20-28). Information as to *performing processing for calculating said communication charge... by summing up...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 12 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 13. Said system, including billing means (C. 5, L. 20-28). Information as to *billing means reflect said meter-rate charge information...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 13 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claims 14. Said system, including billing means (C. 5, L. 20-28).

Claim 15. Said system, as in claim 14. Information as to *billing means produce a detailed statement of usage charge...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from

a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 15 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 16. Said system, wherein said billing means include means for classifying charges in hierarchical manner and a database (Fig. 21; C. 11, L. 55-60). Information as to *the specifics of database* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 16 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 17. Said system, including means for detecting an IP address of communication party (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and means for calculating communication charges (C. 5, L. 20-28). Information as to *by analyzing flow information of communication... and using the discount charge form...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the

claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 17 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 18. Same system as in claim 17. Information as to *calculating from the highest preferential order of group...* is non-functional language and given no patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 18 are disclosed in Farrell as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 19. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and calculating a charge for communication carried out by the user (C. 5, L. 20-28).

Claim 20. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and calculating a charge including a discount for communication carried out by the user (C. 5, L. 20-28).

Claim 21. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and

applying flexible charging and billing to a user for communication carried out by the user (C. 5, L. 20-28); inherently indicating various charging scenarios.

Claim 22. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and applying flexible charging and billing a user for communication carried out by the user if an IP address supplied by the user in advance (C. 5, L. 20-28).

Claim 23. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and calculating flexible charges and billing a user for communication carried out by the user if an IP address supplied by the user in advance (C. 5, L. 20-28).

Claim 24. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and calculating charges with a discount if a user communicates with a previously supplied IP address, and calculating charges at a regular rate if the user communicates with a not pre-registered IP address; and billing a user for said communications (C. 5, L. 20-28).

Claim 25. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and calculating charges with a discount and billing a user for communication carried out by the user with an IP address when said IP address is included in a workgroup and supplied by the user in advance (C. 5, L. 20-28; C. 20, L. 35-38).

Claim 26. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); calculating charges with a discount and billing a user for communication carried out by the user with an IP address when said IP address is included in a workgroup associated with IP addresses supplied by the user in advance; and calculating charges and billing

the user at a different rate if the user communicates with an IP address not included in a workgroup associated with pre-registered IP addresses (C. 5, L. 20-28; C. 20, L. 35-38).

Claim 27. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); and calculating charges with a discount and billing a user for communication carried out by the user with an IP address when said IP address is supplied by the user in advance and associated with a workgroup (C. 5, L. 20-28; C. 20, L. 35-38).

Claim 28. Said method, including: detecting an IP address of a communication party by analyzing flow information (C. 20, L. 34-61; C. 22, L. 44 – C. 23, L. 1); calculating charges with a discount and billing a user for communication carried out by the user with an IP address when said IP address is supplied by the user in advance and associated with a workgroup and calculating charges and billing at a regular rate if the user communicates with an IP address not included in a workgroup associated with pre-registered IP addresses (C. 5, L. 20-28; C. 20, L. 35-38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Farrell.

Claim 5. Farrell teaches all the limitations of claim 5, except teaching that the billing is calculated using a highest preferential order of said workgroup in the preset predetermined conditions. However, it was old and well known at the time the invention was made to use various accounting techniques for billing applications. Furthermore,

the specification does not provide any indication of advantages of said "highest preferential order" feature over the prior art. Without such indication, it appears that calculating charges using a "highest preferential order" of said workgroup is a matter of business choice, and teaching of Farrell would provide calculation of said charges in any preferential order.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

The following U.S. patents are cited to further show the best domestically patented prior art found by the examiner:

US 6,754,706 B1 to Swildens et al. discloses load balancing technique for a domain name system.

US 6,519,051 B1 to Wu et al. discloses use of mapping table for IP address look-up in network communications environment.

The following foreign patent is cited to show the best foreign prior art found by the examiner:

WO 97/40615 to Ronen discloses method for billing transactions over the Internet.

WO 97/29584 to Melen discloses use of IP addresses database for billing transactions over the Internet.

The best non-patent literature located by the examiner is Demise of MCI Friends & Family; the one page Internet print-out, disclosing charging customers at lower rate for calls made to addresses they had included in their calling circle.

Examiner suggests the Applicant review these documents before submitting any amendment.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

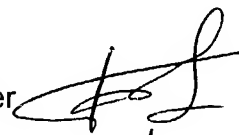
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or faxed to:

(703) 305-7687 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
Art Unit 3629


7/26/04

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